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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,061	06/29/2001	David J. Schmitz	11927/90	9465

7590 08/28/2006
Mark W. Triplett
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive, 32nd Floor
Chicago, IL 60606

EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/896,061	SCHMITZ ET AL.	
	Examiner	Art Unit	
	Frantzy Poinvil	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 5-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al (US Patent No. 6,505,175).

As per claim 1, Silverman et al disclose a system and method for placing and tracking a trade order over an automated execution system. The method and system comprising:

Routing an electronic order for a product submitted by a participant into the automated execution system as

“Referring now to FIG. 2, a trader, customer or other person with access to the Order Management System 130 initiates a trade by entering an order 210 into a network access device such as, for example, a computer. The Order Management System 130 processes the order by properly logging the order and allocating it to a broker ID and a booth, according to the symbol of the security involved in the order. The Order Management System 130 then performs the step of transmitting the order to a booth station 212 and the step of transmitting the order to the Handheld server 213. The handheld server in turn transmits the order to a handheld computing device onto which a Broker ID associated with the security symbol is logged.

Brokers can enter executions according to orders received into a handheld computing device 114-116. The information relating to the orders is transmitted to an online management system for exchange-listed securities. “

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(see on column 4, lines 12-41);

Automatically executing in order priority (column 5, lines 3-13) at least a portion of the electronic order against an order in an electronic book (column 6, lines 1-17) at a prevailing market price (column 4, lines 54-62) irrespective of broker review; and

Automatically executing a remaining portion of the electronic order against the participant at a predetermined participation percentage (column 6, lines 1-19, column 8, line 50 to column 9, line 50).

As per claim 2, Silverman et al teach the any further remaining portion of the electronic order is executed against at least one market maker.

As per claim 3, Silverman et al teach the electronic order further comprises forwarding the electronic order over a computer network system from an order routing system. See column 4, lines 12-41.

As per claim 5, the step of executing a remaining portion of the electronic order against the participant further comprises assigning a percentage of the contra-side of each electronic order to the participant. See column 8, line 50 to column 9, line 50.

As per claims 6 and 7, the product comprises a security, derivative or commodity having at least one sell order or buy order. See column 9, lines 7-18 and column 3, lines 15-20.

As per claim 8, the product is at least one unit of a security, derivative or commodity. See the abstract.

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Ass per claim 9, the participant submits the electronic order for a customer, and inherently the customer is assured to receive the National Best Bid or Offer for the electronic order.

As per claim 10, Silverman et al teach:

Routing an electronic order from an option contract submitted by a participant into an automated execution system over a computer network

"Referring now to FIG. 2, a trader, customer or other person with access to the Order Management System 130 initiates a trade by entering an order 210 into a network access device such as, for example, a computer. The Order Management System 130 processes the order by properly logging the order and allocating it to a broker ID and a booth, according to the symbol of the security involved in the order. The Order Management System 130 then performs the step of transmitting the order to a booth station 212 and the step of transmitting the order to the Handheld server 213. The handheld server in turn transmits the order to a handheld computing device onto which a Broker ID associated with the security symbol is logged.

Brokers can enter executions according to orders received into a handheld computing device 114-116. The information relating to the orders is transmitted to an online management system for exchange-listed securities. "

(see on column 4, lines 12-41);

Receiving the electronic order over the computer network, wherein the electronic order is further routed to a book process subsystem

See also column 4, lines 12-41.

Automatically executing in order priority the electronic order against a book order irrespective of broker review; book (column 6, lines 1-17) and (column 4, lines 54-62);
and

Assigning a first remaining portion of the electronic order to the participant (column 6, lines 1-19, column 8, line 50 to column 9, line 50).

As per claims 11 and 12 see columns 4 and column 9.

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As per claim 12, see column 4, lines 12-49.

As per claim 13, the step of receiving the electronic order over the compute network comprises receiving the electronic order at a trading facility.

See column 3, line 45 to column 4, line 50.

As per claim 14, see column 5, lines 3-13 and column 8, lines 50-61.

As per claim 15, see column 8, lines 50-61.

As per claim 16, the participant submits the electronic order for a customer, and inherently the customer is assured to receive the National Best Bid or Offer for the electronic order.

Claims 17 and 21 are directed to similar limitations recited in claim 1, and therefore these limitations are likewise rejected. See the rejection of claim 1 above.

As per claims 18-20 and 22-23, see columns 4-9 of Silverman et al.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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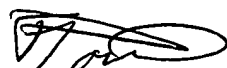
action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Frantzy Poinvil
Primary Examiner
Art Unit 3628**

FP
August 15, 2006